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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,236	08/21/2001	Johann Klein	H-3497 PCTUS	3870

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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,236

Applicant(s)

KLEIN ET AL.

Examiner

Katarzyna Wyrozebski

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-41 is/are pending in the application.
- 4a) Of the above claim(s) 31-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election by Original Presentation

1. Newly submitted claims 33-41 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Newly added claims recite an article comprising a substrate and coating composition that is applied to at least one part of the substrate. New claims claim an article with actual structural limitations not previously subjected to prosecution.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 33-41 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Please note: That when application becomes in condition for allowance and only if restricted claims will contain all the allowable subject matter, the examiner upon attorney's request will rejoin the claims.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 12-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richards (US 6,229,970).

The prior art of Richard discloses aqueous dispersion, which is utilized for making board, by molding a sheet.

According to the claims of the prior art of Richards, the composition comprises two main components, which include polymeric binder and gypsum.

Gypsum, according to Richards, can have two sources (col. 5, lines 35-40). One is by waste desulfurization and although the prior art of Richards does not teach the particle size of the gypsum, it would be reasonable to assume, that since gypsum undergoes the same type of desulfurization process as the gypsum of the present invention, the particle size should be within the same range.

According to claim 1 of Richards, the amount of gypsum is at least 65 % by weight, or as further limited by the spec 65-90 wt %.

According to claim 3 of the prior art of Richards, the binders utilized in the composition include polyvinyl acetate, polyacrylates, polyethylene-polyvinyl chloride, styrene copolymers, acetate/acrylate copolymers. Other polymers are further enabled in col. 7, lines 42-51. The amount of the binder in the composition and according to table in col. 12 is 2.5 wt %. Claims enable one of ordinary skill in the art to use 1-3 wt %.

Additional additives according to claims of Richards, include glass wool (claim 6), clay and vermiculite (claim 5), wherein kaolin is clay.

Gypsum such as that of the prior art of Richards is formed by waste desulfurization process and thereby provides the same type of gypsum as that of the present invention. Utilizing the same process in making gypsum component, renders is obvious that the particle size of the obtained gypsum would also be comparable to that of the present invention.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize the composition of the prior art of Richards and thereby arrive at the present invention. Utilizing the composition of Richards would result in molding composition as claimed in the present claims.

6. Claims 12-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richards (US 6,229,970) in view of CLEMMENS (US 5,169,617).

The prior art of Richard discloses aqueous dispersion, which is utilized for making board, by molding a sheet.

According to the claims of the prior art of Richards, the composition comprises two main components, which include polymeric binder and gypsum.

Gypsum, according to Richards, can have two sources (col. 5, lines 35-40). One is by waste desulfurization and although the prior art of Richards does not teach the particle size of the gypsum, it would be reasonable to assume, that since gypsum undergoes the same type of desulfurization process as the gypsum of the present invention, the particle size should be within the same range.

According to claim to of Richards, the amount of gypsum is at least 65 % by weight, or as further limited by the spec 65-90 wt %.

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According to claim 3 of the prior art of Richards, the binders utilized in the composition include polyvinyl acetate, polyacrylates, polyethylene-polyvinyl chloride, styrene copolymers, acetate/acrylate copolymers. Other polymers are further enabled in col. 7, lines 42-51. The amount of the binder in the composition and according to table in col. 12 is 2.5 wt %. Claims enable one of ordinary skill in the art to use 1-3 wt %.

Additional additives according to claims of Richards, include glass wool (claim 6), clay and vermiculite (claim 5), wherein kaolin is clay.

The difference between the present invention and the disclosure of the prior art of RICHARDSON is specific recitation of particle size of gypsum.

With respect to the above difference, the prior art of CLEMMENS discloses gypsum particles that have been formed *via* flu-gas desulfurization and which particles have diameter of 200 microns or less.

Gypsum such as that of the prior art of Richards is formed by waste desulfurization process and thereby provides the same type of gypsum as that of the present invention. CLEMMENS also discloses gypsum particles formed by flu-gas desulfurization, which has particle size of 200 microns or less. Utilizing the same process in making gypsum component, renders is obvious that the particle size of the obtained gypsum would also be comparable to that of the present invention.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize gypsum of CLEMMENS in the composition of RICHARDSON and thereby obtain the claimed invention. Such modification would successfully produce articles disclosed in RICHARDSON.

Rejection under 35 U.S.C. §112

7. Rejection of claims 28 and 30 is hereby withdrawn, since the articles formed are in alternate form.

Applicant's Arguments

a) In their arguments submitted on 8/6/2004 applicant's argued that the prior art of RICHARDSON does not teach the particle size of the present invention and that different desulfurization processes form different particle size of gypsum.

With respect to the above argument, in the advisory action mailed on 5/5/2004, the burden was shifted to the applicants to provide factual evidence that flu-gas desulfurization process would not be expected to produce particles of the present invention.

b) Examiner is not clear as to why applicants addressed the disclosure of CLEMMENS, since CLEMMENS merely requires gypsum formed by flu-gas desulfurization process.

The point is that the gypsum of CLEMMENS that is formed by flu-gas desulfurization has particular particle size claimed by the present invention.

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c) The applicants have cited MPEP that "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness...."

The examiner has done that by submitting supporting reference of CLEMMENS, which shows that the particle size of gypsum formed *via* flu-gas desulfurization is 200 microns or less and thereby shifting burden onto applicants to show otherwise. It is examiner's position that the applicants have not provided such factual evidence.

d) The applicants argued that the property of particle size is not inherent.

The inherency is a value given to rejection that qualifies as an anticipation rejection. The rejection over the prior art of Richard is not anticipatory rejection but obviousness type rejection.

e) The present invention discloses composition that has decreased shrinkage that is not taught or suggested by the art of RICHARDSON.

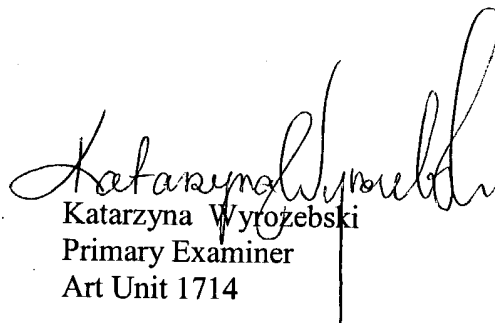
The property of decreased shrinkage would result from combination of the components therein. Therefore if components of the prior art of RICHARDSON encompass the composition of the present invention the property would be intrinsic.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Katarzyna Wyrozebski
Primary Examiner
Art Unit 1714

November 5, 2004